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EXAMINER

SAADAT, CAMERON

ART UNIT	PAPER NUMBER
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3713

DATE MAILED: 04/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The antecedent basis for “the user” has not been clearly set forth.

Claims 3-4 are rejected for incorporating the above errors from their respective parent claims by dependency.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claims 1-2, 5-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Brennan et al. (USPN 5,906,369; hereinafter Brennan).**

Regarding claim 1, Brennan discloses an apparatus for determining the identification of selected objects for use in connection with an electronic children’s toy, the apparatus comprising: a plurality of objects 18, 20, 22, 24, 26, and 28 which include a plurality of object contact elements 72a-d and 76 (see Figs. 8-9), wherein two or more of the contact elements are connected to form a contact pattern which serves to uniquely identify the object (Col. 5, lines 66-67); and an identification member 50 capable of being placed in physical contact with the object

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contact elements (see Fig. 22); the identification member including a plurality of member contact elements configured such that at least two of the object contact elements come into electrical contact with at least two of the object contact elements when the identification member is placed in contact with one of the objects (Col. 5, lines 25-27); and a processing unit in electrical contact with the identification member capable of detecting the object contact pattern and determining the identification of the particular object (Col. 6, lines 21-26).

Regarding claim 2, Brennan discloses an apparatus further comprising a means of providing audio information corresponding to the identification of the object in contact with the identification number (Col. 6, lines 21-26).

Regarding claim 5, Brennan discloses an apparatus wherein the identification member includes at least three contact elements arranged linearly (See Fig. 21, refs. 62).

Regarding claims 6 and 8, Brennan discloses an apparatus wherein the objects include at least two contact elements arranged such that each of the object contact elements comes into physical contact with a corresponding one of the identification member contact elements (see Fig. 21).

Regarding claim 7, Brennan discloses an apparatus wherein the identification member includes at least four contact elements arranged in at least two linear rows (See Fig. 21, refs. 62).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. **Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brennan et al. (USPN 5,906,369; hereinafter Brennan) in view of Jessop (USPN 6,171,168 B1).**

Brennan discloses all of the claimed subject matter, yet does not specify computer-generated human speech (as per claim 3) or movement of a portion of the apparatus (as per claim 4) in response to identifying objects that are in physical contact with the identification member.

However, Jessop discloses an apparatus for identifying objects, comprising computer-generated human speech (Col. 12, example 1) and movement of the object (Col. 12, example 3) in response to identifying objects that are in physical contact with the identification member. Hence, At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify the response of the identification member described in Brennan, by providing computer-generated human speech and movement in response to identifying objects that are in physical contact with the identification member, in light of the teachings of Jessop. The motivation for doing so would have been to add functionality to the objects (toys) by generating sounds and movement appropriate to the objects identity or environment (see Jessop, Col. 1).

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7. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brennan et al. (USPN 5,906,369; hereinafter Brennan) in view of Lipsitz et al. (USPN 4,348,191; hereinafter Lipsitz), still further in view of Chuang (USPN 6,022,025).

Brennan discloses an apparatus for determining the identification of selected objects for use in connection with an electronic children's toy, the apparatus comprising: a plurality of objects 18, 20, 22, 24, 26, and 28 which include a plurality of object contact elements 72a-d and 76 (see Figs. 8-9), wherein two or more of the contact elements are connected to form a contact pattern which serves to uniquely identify the object (Col. 5, lines 66-67); and an identification member 50 capable of being placed in physical contact with the object contact elements (see Fig. 22); the identification member including a plurality of member contact elements configured such that at least two of the object contact elements come into electrical contact with at least two of the object contact elements when the identification member is placed in contact with one of the objects (Col. 5, lines 25-27); and a processing unit in electrical contact with the identification member capable of detecting the object contact pattern and determining the identification of the particular object (Col. 6, lines 21-26).

Brennan discloses all of the claimed subject matter excluding the incorporation of the identification member into a fishing pole and hook. However, Chuang discloses a children's toy comprising a fishing pole device including a rod member 1 and a hook member 42; a an object 5 comprising an aperture configured for accepting engagement of the hook member when the hook member 43 is placed in physical contact with the object 5; and providing movement of the hook member relative to the rod member (as per claim 12).

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Furthermore, Lipsitz discloses a children's toy wherein an identification member is configured to engage with analogous objects. For instance, identification member 7 (a pond) is configured to engage with objects that are analogous with a pond (a duck, frog, or boat) (see column 2, lines 36-36). In the same way identification member 11 represents a field and corresponds to an object comprising a tractor. Thus, the Lipsitz reference suggests that the identification member should be somehow related to the object.

At the time of the invention, in view of Chuang and Lipsitz, it would have been obvious to a person of ordinary skill in the art to modify the identification member described in Brennan by providing a fishing pole and hook to engage with and identify objects that correlate with a fishing pole and hook, in order to present a correlation between a fishing hook and a fish.

Regarding claim 10, Brennan discloses an apparatus further comprising a means of providing audio information corresponding to the identification of the object in contact with the identification number (Col. 6, lines 21-26).

8. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brennan et al. (USPN 5,906,369; hereinafter Brennan) in view of Lipsitz et al. (USPN 4,348,191; hereinafter Lipsitz), still further in view of Chuang (USPN 6,022,025), still further in view of Jessop (USPN 6,171,168 B1).

Brennan, Lipsitz, and Chuang disclose all of the claimed subject matter, yet the combination does not specify computer-generated human speech in response to identifying objects that are in physical contact with the identification member. However, Jessop discloses an apparatus for identifying objects, comprising computer-generated human speech (Col. 12, example 1) in response to identifying objects that are in physical contact with the identification

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member. Hence, at the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify the response of the identification member described in the combination of Brennan, Lipsitz, and Chuang, by providing computer-generated human speech in response to identifying objects that are in physical contact with the identification member, in light of the teachings of Jessop. The motivation for doing so would have been to add functionality to the objects (toys) by generating sounds and movement appropriate to the objects identity or environment (see Jessop, Col. 1).

9. Claims 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brennan et al. (USPN 5,906,369; hereinafter Brennan) in view of Shackelford (USPN 6,227,931 B1).

Regarding claim 13, Brennan discloses a method for determining the identification of selected objects for use in connection with an electronic children's toy, the method comprising: engaging an identification member including a plurality of electrically conductive member contact elements 62 forming a unique contact pattern (Col. 6, lines 15-16); such that two of the member contact elements are brought into electrical contact with one another; determining which of the member contact elements (switches) have been actuated, thereby determining the contact pattern of the object which is in physical contact with the identification member.

Brennan does not explicitly disclose that the object contact elements are conductive, or passing an electrical current through the object contact elements. However, Shackelford discloses a children's toy, wherein a identification member comprises conductive contacts that pass a current through conductive contact elements of an object. Hence, at the time of the invention, it

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would have been obvious to a person of ordinary skill in the art to modify the contact elements described in Brennan, by prescribing conductive contact elements for the object, in light of the teachings of Shackelford, in order to pass a current through a resistive portion of the object, thereby determining the identity of the object based on measured R-C circuit characteristics (see Shackelford, column 7).

Regarding claim 14, Brennan discloses an apparatus further comprising a means of providing audio information corresponding to the identification of the object in contact with the identification number (Col. 6, lines 21-26).

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Lee et al. (USPN 4,968,255) – disclose an educational toy wherein objects are inserted into an object identifier.
- Weiner (USPN 4,820,233) – discloses a toy comprising an object identifier.
- Kavarizadeh (USPN 6,524,159 B1) – discloses a toy comprising an object identifier.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cameron Saadat whose telephone number is 703-305-5490. The examiner can normally be reached on M-F 8:00 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on 703-308-4119. The fax phone numbers

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for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

CS

March 17, 2004